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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,896	11/15/2000	Tohru Kayano	KAYANO I	8185

7590

03/17/2003

Browdy and Neimark
624 Ninth Street N W
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EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 03/17/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/711,896

Applicant(s)

Kayano et al.

Examiner

S. Devi, Ph.D.

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 25, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Restriction

1) Claims 1-26 are under prosecution.

2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses 24 hours a day and 7 days a week. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3) Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 5, drawn to an antibody specific to an interleukin 18 propeptide sequence of SEQ ID NO: 1, classified in class 530, subclass 387.9.
- II. Claim 5, drawn to an antibody specific to an interleukin 18 propeptide sequence of SEQ ID NO: 2, classified in class 530, subclass 387.9.
- III. Claim 11, drawn to a process of preparing an antibody to an interleukin 18 propeptide sequence of SEQ ID NO: 1, classified in class 436, subclass 547.
- IV. Claim 11, drawn to a process of preparing an antibody to an interleukin 18 propeptide sequence of SEQ ID NO: 2, classified in class 436, subclass 547.
- V. Claims 16-18, drawn to a method of detecting interleukin 18 precursor using an antibody thereto, classified in class 435, subclass 7.1
- VI. Claims 19-21, drawn to a combination detection method comprising detecting interleukin 18 precursor using an antibody thereto and detecting mature interleukin 18 using an antibody to mature interleukin 18, classified in class 435, subclass 973
- VII. Claims 22 and 23, drawn to a method of purifying interleukin 18 precursor using an antibody to interleukin 18 precursor, classified in class 436, subclass 518

Claims 1-4, 6-9 and 24-26 are considered as linking claims and would be joined with one

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of inventions I and II, if elected.

Claims 10 and 12-15 are considered as linking claims and would be joined with one of inventions III and IV, if elected.

4) Inventions I through VII are distinct from one another. Inventions I and II are directed to two distinct antibodies specific to distinct antigens that differ from one another structurally, functionally and immunogenically. Inventions III through VI are directed to distinct methods that differ from one another in method steps and parameters, compositions or reagents used and the ultimate goals accomplished. Although inventions I and II as well as inventions III and IV belong to the same class/subclass, separate sequence searches that are non-coextensive are needed. The method of invention VI differs from the method of invention V in requiring a second antibody additional to an antibody specific to interleukin 18 precursor.

5) Inventions I and II each and inventions V, VI and VII are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the antibody of invention I or II can be used in a non-detection process, for example, as an immunogen to produce anti-idiotypic antibodies.

6) Inventions I and III as well as inventions II and IV are related as product and process of making the product. The inventions are distinct if either or both of the following can be shown: (1) that the processes as claimed can be used to make other and materially different products or (2) that the products as claimed can be made by another and materially different processes (MPEP 806.05(f)). In the instant case, the antibody product of invention I or II can be made by a process materially different from the process of invention III or IV, i.e., without immunizing an animal, for example, by chemical synthesis.

Because these inventions are distinct for the reasons given and have acquired a separate status in the art as shown by their divergent subject matter and because these inventions require searches that are not co-extensive, restriction for examination purposes as indicated is proper.

7) Applicants are advised that the response to this requirement to be complete must include

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an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

8) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

9) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday through Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March, 2003


S. DEVI, PH.D.
PRIMARY EXAMINER



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: S. DEVI, Ph.D.

ART UNIT: 1645

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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COMMENTS: _____

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

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